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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,264	11/12/1999	KUNIHICO MIWA	JA9-98-171	1450

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HOLLAND & HART, LLP  
555 17TH STREET, SUITE 3200  
DENVER, CO 80201

EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

**Office Action Summary**

Application No.

09/439,264

Applicant(s)

MIWA ET AL.

Examiner

Firmin Backer

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-24, 27-29 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-24, 27-29 and 32-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3                      6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 5, 2003 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-24, 27-29 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa et al (U.S. Patent No. 6,230,268) in view of Ueda et al (U.S. Patent No. 6,289,102).

4. As per claim 21, Miwa et al teach a method of recording digital data onto a medium comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark is electronically embedded in the digital data through a transformation of the digital data and if the watermark is detected, then performing access control for the digital data using the watermark (*see abstract, column 2 lines 35-3 line 16,*

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3 lines 41-55). Miwa et al fail to teach an inventive concept of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium. However, Ueda et al teach an inventive concept of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium (*see abstract, column 2 lines 43-52, 3 lines 52-59*). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

5. As per claim 22, Miwa et al teach a method of determining whether copying/recording of the digital data is to be stopped or continued (*column 4 lines 10-39*).

6. As per claim 23, Miwa et al teach a method further comprises embedding a copy mark into the digital data in accordance with a content of the digital watermark (*see abstract, column 2 lines 35-3 line 16, 3 lines 41-55*).

7. As per claim 24, Miwa et al teach a method of recording digital data onto a medium comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark and a copy mark that is electronically embedded in the digital data through a transformation of the digital data and if the watermark is detected, then

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performing playback control for the descrambled digital data using the watermark and the copy mark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55*). Miwa et al fail to teach an inventive concept reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium. However, Ueda et al teach an inventive concept of reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium (*see abstract, column 4 lines 25-34, 53-65*). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

8. As per claim 27 and 32, Miwa et al teach a video driver comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark and a copy mark that is electronically embedded in the digital data through a transformation of the digital data and if the watermark is detected, then performing playback control for the descrambled digital data using the watermark and the copy mark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55*). Miwa et al fail to teach an inventive concept for decoding a scrambled digital data and descrambling the scrambled digital data. However, Ueda et al teach an inventive concept of for decoding a scrambled digital data and descrambling the scrambled digital data (*see abstract, column 4 lines 25-34, 53-65*). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive

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concept to include Ueda et al's of for decoding a scrambled digital data and descrambling the scrambled digital data because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

9. As per claim 28, 29, 33 and 34, Miwa et al teach a video driver card wherein the scrambling digital data is an MPEG stream, and determining whether or not to output the MPEG stream and adding a copy mark to the MPEG stream (*see fig 4, column 5 lines 41-63, 6 lines 18-49*).

### ***Response to Arguments***

10. Applicant's arguments filed September 5, 2003 have been fully considered but they are not persuasive.

a. Applicant has amended the claims and has argues that the prior art fail to teach and inventive concept of using and encryption key to reproduce/recover a digital data. Examiner respectfully disagrees with applicant characterization of the prior arts. Miwa teaches an inventive concept of wherein an information recording medium according to the present invention includes a lead-in area and a data recording area. Key information is recorded in the lead-in area. Scrambled data is recorded in the data recording area. The scrambled data is descrambled based on the key information. Nevertheless the process of scrambled/encoded using encrypting key is very well know in the art of cryptography. It

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would have been obvious to one of ordinary skill in the art to scramble data using encryption key because this would provide greater security to the encrypted data.

Furthermore Applicant argues that the prior art fail to teach an inventive concept of inhibiting the subsequent copy or playback of the digital data in the absence knowledge of the encryption key. Examiner respectfully disagrees with applicant characterization of the prior arts. Miwa teaches an inventive concept of wherein where the disk reproducing device 2 determines that copying of the disk 3 is permitted, correct user data which has been subjected to the descramble-processing in accordance with the scramble information read from the lead-in area in the disk 3, at the time of the start-up operation of the disk reproducing device 2, is transmitted to the host computer 1. On the other hand, in the case where the disk reproducing device 2 determines that the copying of the disk 3 is prohibited, erroneous user data which has been subjected to descramble-processing inconsistent with the scramble information is transmitted to the host computer 1.

Alternatively, it is possible to prevent the disk reproducing device 2 from transmitting back correct data to the host computer 1 by conducting an error processing or the like.

Thus, illegal copying can be prevented.

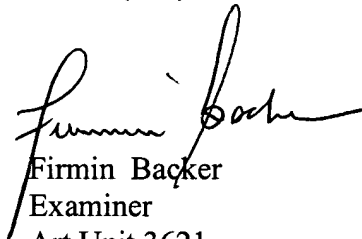
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer  
Examiner  
Art Unit 3621

September 5, 2003